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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/425,271 10/21/99 TOUTOUNTZIS

V T257.312-000

000164 PM82/0329  
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EXAMINER

CANFIELD, R

ART UNIT

PAPER NUMBER

3635

DATE MAILED:

03/29/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/425,271

Applicant(s)

Toutountzis

Examiner

Robert Canfield

Group Art Unit  
3635



☒ Responsive to communication(s) filed on Oct 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8, 25, 29, 32, and 62 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8, 25, 29, 32, and 62 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Oct 21, 1999 is ☐ approved ☒ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 17/575908, 08/040305

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 sheets

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This is a first Office action on the merits for application serial number 09/425271 filed as a continuation of application serial number 08/859561 which is a reissue of application serial number 08/040305, U.S. Patent 5,417,017. This Office action is in response to the preliminary amendment filed 10/21/99. Claims 1-8, 25, 29, 32 and 62 are pending. Claims 9-24, 26-28, 30, 31, and 33-61 have been canceled.
2. The examiner acknowledges receipt of the IDS filed 10/21/99. An initialed copy of the 2 sheets of 1449 is attached.
3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copies have been filed in parent Application No. 07/575908, filed on 08/31/90 and parent Application No. 08/040305, filed on 03/30/93.
4. 37 CFR 1.172 requires that all assignees owning an undivided interest consent to the filing of a reissue application. If there is no assignee applicant must state such. Without such a statement it is assumed that the patent and/or application is assigned. ✓
5. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01. ✓

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A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. ✓

7. The proposed drawing correction filed on 10/21/99 has been disapproved because any change to any of the patent drawings must be in the form of a new sheet of drawings with any amended figure identified as "**amended**". See MPEP 1414. The proposed change to figure 6 would otherwise be approved. ✓

8. The examiner acknowledges receipt of request to transfer drawings from the original patent. It is noted that the original drawings may only be used in lieu of new drawings when no alterations whatsoever are made. A sheet of original drawings cannot be amended and cannot be transferred from the original patent when drawing amendments are expected. See MPEP 1414.

9. The disclosure is objected to because of the following informalities: all Certificate of Correction changes must be entered in a reissue application without bracketing or underlining so

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as to incorporate the changes as part of the original patent and not as changes in the reissue. The specification filed 10/21/99 fails to include the changes made by the Certificate of Correction filed 05/19/97.

Appropriate correction is required.

10. A substitute specification excluding claims is required including the changes made by Certificate of Correction.. Applicant is reminded that the specification must be presented in single column form as a "cut-out" of the original patent incorporating the changes made by Certificate of Correction without any underlining or bracketing.

11. Claims 1-8, 25, 29, 32 and 62 are rejected under 35 U.S.C. 251 as lacking basis for reissue.

By statute a reissue application can only be granted for the unexpired portion of the term of the original patent. There is no record of the 3.5 year maintenance fee having been paid for U.S. Patent 5,417,017. **In re Morgan**, 990 F 2d. 1230, 26 USPQ2d 1392 (Fed. Cir. 1983).

12. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: it does not cover the preliminary amendment made 10/21/99.

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13. Claims 1-8, 25, 29, 32 and 62 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

14. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

15. Claims 1, 4, 7, 8, 25, 29, 32 and 62 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow

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scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitation defining the dimensions of the pores has been omitted from each of the above identified claims. This omission provides a broadening aspect in the reissue claims as compared to the claims of the patent. The limitation of the dimension of the pores was originally argued in at least the remarks of the amendment filed 06/29/92 in application serial number 07/825299 to make the claims allowable over a rejection. Thus the omitted limitation relates to subject matter previously surrendered, in the original application.

The examiner acknowledges the he rejected the limitation in parent application 08/859561 under 112(2) as being indefinite. Note however, it was the language defining the dimensions of the pores in terms of the termite that was considered indefinite, not the mere presence of limitation defining a dimension.

The limitations of the sheet being a mesh sheet in claims 25, 29, 32, and 62, and the relationship to the structure as found in any of the original claims have been omitted from method claims 25, 29 and 32. These omissions provide further broadening aspects to the claims as compared to the claims of the patent.

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16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 4, 25, 29, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,549,385 to Cohen et al.

Reinforcing steel 15 is shown embedded in slab 20. The steel is provided with open pores and is coextensive with the slab. Steel inherently has a hardness of at least about Shore D70.

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,017,106 to Sandell.



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Sandell provides a wire mesh embedded in a moisture impervious sheet as shown in Figure 2. Figure 4 shows the sheet positioned in relation to a structure and ground.

Sandell fails to provide the pore dimensions and hardness of the mesh. Sandell does state that the wire mesh size may be varied as needed.

The particular pore dimensions are viewed as choices of design which would have been obvious at the time of the invention to one having ordinary skill in the art as Sandell suggests the pore dimensions may be varied as needed.

Stainless steel is a well known material for use in wire meshes and would have been an obvious material choice for the mesh of Sandell to one having ordinary skill in the art at the time of the invention for its inherent material properties such as corrosion resistance. Stainless steel inherently meets the claimed hardness.

20. Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by the Translation of Les Termites Et La Protection des Constructions reference.

Page 22 of the translation shows under the heading "Type of Metallic Dilation Joints" a slab of concrete adjacent a non-integral footing with a metallic sheet of material having respective marginal edge portions integrally secured to the slab and footing to provide a termite barrier. It is inherent that the material is substantially resistant to termite secretions and has the required hardness because of the intended use as a termite barrier.

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21. Claim 62 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 2,316,660 to Bailey.

Bailey provides a flexible sheet of metal 10 between a slab 18 and footing 17. Bailey fails to specify the hardness of the metal. The examiner takes Official Notice that the metal sheet of copper recited inherently has a Shore D hardness of at least about 70 D. In the alternative, the sheet metals which would have been obvious material choices as alternatives to the copper sheet to one having ordinary skill in the art at the time of the invention such as stainless steel inherently have Shore D hardness of not less than about 70D.

22. Applicant's arguments filed 10/21/99 have been fully considered but they are not persuasive.

In response to applicant's argument that the Sandell reference is not a "termite barrier" and that Sandell does not disclose or suggest the purpose the sheet is for use as a termite barrier, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Applicant's argument concerning the mesh size is not found persuasive. The passage applicant relies upon relates to when the sheet is used in such locations with mortar between adjacent courses of masonry bound together. The passage relied upon

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follows the language "in certain instances ...it is desirable". This would suggest to one having ordinary skill in the art that depressions sufficient for the entry of binding material is not a requirement. It is presented as a feature which may be desired in certain uses not all uses (see for example location 'e').

It is the examiner's position that the language "strong closely woven fabric", "wire fabric" and "it is evident that the size of the wire of which the fabric 13 is constructed and the mesh of the fabric may vary according to the purpose for which the waterproof sheet may be utilized" (all found at the bottom of column 2 of page 1) would adequately suggest to one of ordinary skill in the art at the time of the invention that the "closely woven" mesh could have been dimensioned within the dimensional limitations of the claims. The reference taken as a whole strongly suggests a closely woven mesh of size which may be varied for its intended use. While Sandell may not teach or suggest the intended use of applicant's claims it is the examiner's position that Sandell adequately suggests dimensioning his mesh within the dimensional limitations set forth in the claims.

As noted above an intended use must result in a structural difference. It remains the examiner's position that there is no structural difference between claims 1-8 and the sheet of Sandell at least when provided in location 'e'.

In response to applicant's argument that Sandell does not provide the pores sizes, one cannot show non obviousness by attacking references individually where the rejections are based on an obvious type rejection. The examiner has acknowledges that Sandell fails

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to provide the claimed sizes but has rejected the sizes as being obvious choices of design because Sandell suggests that the mesh size may be varied as desired.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2482. The examiner can normally be reached on M-Th.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Robert Canfield

March 24, 2000

Robert Canfield  
Primary Examiner